

REMARKS

This Amendment amends claim 1. The 30,000 g/mol minimum molar mass feature of claim 1 is taken from claim 9. A version with markings to show changes made is attached as an Appendix. Claims 1, 2, 4-16, 18 and 19 are pending.

Entry of this Amendment is respectfully requested, as it is believed (1) to place the application in condition for allowance, (2) not to raise any new issue or require further search by the Examiner, (3) to be directly responsive to the Final Rejection, and (4) to place the application in even better form for appeal, should such appeal be necessary. In particular, the amendment of claim 1 to recite a minimum molecular weight of 30,000 g/mol cannot raise a new issue or require further search because this feature of the invention has been present in claim 9 from the beginning of prosecution.

The 35 U.S.C. § 103(a) rejection of claims 1, 2, 4-16, 18 and 19 over U.S. Patent No. 5,552,454 to Kretschmann et al. is respectfully traversed. The claimed composite is a mixture of a thermoplastic component and a bioactive component, with the thermoplastic component having a molar mass within the range 30,000 - 1,000,000 g/mol. and the bioactive component being either a bioactive glass or a bioactive xerogel

Kretschmann et al. fails to raise a prima facie case of obviousness against the claimed composite. Kretschmann et al. discloses at least partly resorbable materials whose molecular weight can range from 200 to 10,000 g/mol (Col. 4, lines 15-20). One of ordinary skill in the art is given no disclosure or motivation to raise the Kretschmann et al. maximum molecular weight limit by 200 percent. Instead, Kretschmann et al. teaches that molecular weight regulation is important to its invention (Col. 3, lines 8-13), and discloses a preferred, lower range of from about 300 to about 5,000 g/mol.

Even assuming, arguendo, that a Kretschmann et al. composite having its maximum molecular weight limitation of 10,000 g/mol would inherently have the improved moldability properties discovered by the applicant, there is no recognition of these properties in the reference. It is clear that an obviousness rejection cannot be based on what a reference "inherently" discloses:

[T]he inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.

In re Spormann, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966).



U.S. Patent Application S.N. 09/446,630
AMENDMENT AFTER FINAL REJECTION

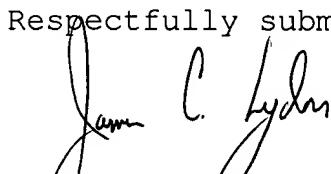
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Reconsideration and withdrawal of the obviousness rejection of claims 1, 2, 4-16, 18 and 19 over Kretschmann et al. are earnestly requested.

It is believed that the application is in condition for allowance. Reconsideration and withdrawal of all rejections of claims 1, 2, 4-16, 18 and 19, and issuance of a Notice of Allowance directed to those claims, are earnestly requested. The Examiner is urged to telephone the undersigned should he believe any further action is required for allowance.

It is not believed that any other fee is required for entry and consideration of this Amendment. Nevertheless, the Director is authorized to charge our Deposit Account No. 50-1258 in the amount of any such required fee.

Respectfully submitted,


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Enclosure:
Appendix